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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,528	08/29/2001	Takayuki Iida	Q64676	4729

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EXAMINER
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DIVINE, LUCAS

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/940,528

Applicant(s)

IIDA, TAKAYUKI

Examiner

Lucas Divine

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 29 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### *Claim Objections*

2. Claims 9 and 10 objected to because of the following informalities: these claims list that the image information reading section reads the image data (see last two lines of page 36 for example) formed on the image recording medium. It is stated in the independent claim that the information reading section reads the image information from the image recording medium and that the data is located at the server and is read by the image data reading section. Examiner believes that the word 'data' in each claim was meant to be 'information.' Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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3. Claims 1 – 4, 7, 8, 11, 12, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Shih et al. (US 6674923) hereafter as Shih.

Regarding claim 1, Shih teaches a **printing system** (Fig. 14) **comprising:**

**an image server** (82, which includes image memory 94; col. 1 lines 64-67, col. 6 lines 48-51) **in which image data of an image formed on an image recording medium** (data stored is of the developed images 35, Fig. 3), **is stored;**

**an image reading section for reading the image formed on the image recording medium** (col. 4 lines 36-39, wherein Shih teaches that a user can scan in the image if they would like and print it that way, scanning inherently including a scanner for image reading);

**an image information reading section** (reading device 105 on kiosk 98 [Fig. 15]; col. 8 lines 44-47, col. 2 lines 4-5) **for reading, from the image recording medium** (barcode 32 on image recording medium 35, Fig. 4), **image information including information for specifying the image server and a position at which the image data is stored in the image server** (URL 26 is embedded in the machine readable code 32, col. 4 lines 10-20, col. 2 lines 17-21);

**an image data reading section** (92, which reads the requested data from the image memory 94 and forwards the data to the destination required, for example, photofinishing section 62 for printing; col. 7 lines 24-25) **for reading the image data corresponding to the image information from the image server based on the image information read by the image information reading section** (col. 4 lines 31-34, wherein the images pointed to by the URL can be selected for reprint and the data is read out and sent to the printing section); **and**

**an image reproduction section** (photofinishing section 62 includes printers 84, 86, and 88 for reproducing image data for first prints or reprints) **for forming, on another image**

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**recording medium which is different from the image recording medium** (reprints are made, thus the reprint is essentially not on the same print as the first print), **the image formed on the image recording medium based on *one* of image data, read by the image reading section, of the image** (col. 4 lines 36-39, wherein Shih teaches that a user can scan in the image if they would like and print it that way) **or the image data read by the image data reading section** (col. 2 lines 5-6, wherein reprints can be ordered based on the image data in the server).

Regarding claim 2, which depends from claim 1, Shih teaches **the image information reading section is provided so as to read the image information recorded as an invisible image on the image recording medium** (col. 9 line 62 – col. 10 line 6, wherein the data can be stored as hidden [not visible to the user] form in the image itself).

Regarding claims 3 and 4, which depend from claims 1 and 2, Shih teaches **the image information reading section is provided so as to read the image information recorded as a bar code on the image recording medium** (barcode 32 is read by reading section 105, col. 4 line 11 and col. 8 lines 43-44).

Regarding claims 7 and 8, which depend from claims 1 and 2, Shih teaches **the image reading section is used as the image information reading section** (col. 9 line 55, wherein the scanner of a user could be used as the barcode reader).

Regarding claim 11, the structural elements of apparatus claim 1 perform all of the method steps of method claim 11 except for the step listed below. Shih further teaches **reading in image data recorded in an image carried** (scanner 68 reads data from image carriers 64 and 65, memory card reader and CD reader read from image carriers 108 and 106 respectively – col.

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9 lines 3-10 teach the prints and digitally stored files can originate from any of the aforementioned carriers) **and the formed image is based on the data read from the image carrier** (formed image 35 [Fig. 3] is based on the data input to the system via input devices shown in Fig. 14, one of which can be an image carrier such as 106, 108, 64, 65). Thus, method claim 11 is rejected for the same reasons stated above in the rejection of apparatus claim 1 as well as the additional reasons stated.

Regarding claim 12, which depends from claim 11, the structural elements of apparatus claim 2 perform all of the method steps of method claim 12. Thus, method steps of method claim 12 are rejected for the same reasons stated in the rejection of apparatus claim 2.

Regarding claim 15, which depends from claim 11, the structural elements of apparatus claim 3 perform all of the method steps of method claim 15. Thus, method steps of method claim 15 are rejected for the same reasons stated in the rejection of apparatus claim 3.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5 and 6 rejected under 35 U.S.C. 103(a) as being unpatentable over Shih as applied to claims 1 and 2 above, and further in view of Nelson et al. (US 6431448) hereafter as Nelson.

Regarding claims 5 and 6, which depend from claims 1 and 2, while Shih teaches scanning in images for possible printing (col. 4 lines 36-39, wherein Shih teaches that a user can scan in the image if they would like and print it that way), Shih does not specifically teach that the scanner and image information reading device 105 are both in the same device, e.g. kiosk 98.

Nelson teaches a photo kiosk (Fig. 1) for accessing the network and an image storage service and photofinishing service similar to the system of Shih. Nelson further teaches a scanner located at the kiosk (scanner 56).

It would have been obvious to one of ordinary skill in the art to place the scanner spoken of in Shih at the kiosk as taught in Nelson. The motivation for doing so would have been to have all the services needed for the user at one location, thus the intention of a kiosk. The kiosk in the system is designed to take all the functions of a home computer and associated peripherals and place them in a kiosk so that a user who doesn't have a computer can access the same services. Further, Shih and Nelson are both assigned to the same entity, thus implying that the systems work together.

5. Claims 9, 10, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shih as applied to claims 1, 2, and 11 above, and further in view of Bryniarski et al. (US 6215559) hereafter as Bryniarski.

Regarding claims 9 and 10, which depend from claims 1 and 2, while Shih teaches **the image reading section and the image information reading section are provided so as to read the image and the image data formed on the image recording medium, and an image is formed on a by the image reproduction section** (discussed in the rejection of claim 1) and that

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the photofinishing section develops photos, Shih does not specifically teach that the *photofinishing* section 62 can print on **photographic photosensitive material**.

Bryniarski teaches that photofinishing labs where film is developed, such as the photofinishing section of Shih, can print on **photographic photosensitive material** (col. 4 lines 49-50).

It would have been obvious to one of ordinary skill in the art that the photo processing system of Shih prints photographs such as 35 on photosensitive material. The motivation for doing so would have been to print high quality prints without using ink and photosensitive material prints are generally sturdier than standard paper. Further, Shih and Bryniarski are both assigned to the same entity, thus implying that the systems work together.

Regarding claim 13, which depends from claim 11, while Shih teaches that the **image carrier is a photographic film** (film 64, Fig. 14) Shih does not specifically teach that the *photofinishing* section 62 can print on **photographic photosensitive material**.

Bryniarski teaches that photofinishing labs where film is developed, such as the photofinishing section of Shih, can print on **photographic photosensitive material** (col. 4 lines 49-50).

It would have been obvious to one of ordinary skill in the art that the photo processing system of Shih prints photographs such as 35 on photosensitive material. The motivation for doing so would have been to print high quality prints without using ink and photosensitive material prints are generally sturdier than standard paper. Further, Shih and Bryniarski are both assigned to the same entity, thus implying that the systems work together.



Regarding claim 14, which depends from claim 11, while Shih teaches **the image carrier is a media for recording image data of an image photographed by a digital still camera** (media 108, Fig. 14), Shih does not specifically teach that the *photofinishing* section 62 can print on **photographic photosensitive material**.

Bryniarski teaches that photofinishing labs where film is developed, such as the photofinishing section of Shih, can print on **photographic photosensitive material** (col. 4 lines 49-50).

It would have been obvious to one of ordinary skill in the art that the photo processing system of Shih prints photographs such as 35 on photosensitive material. The motivation for doing so would have been to print high quality prints without using ink and photosensitive material prints are generally sturdier than standard paper. Further, Shih and Bryniarski are both assigned to the same entity, thus implying that the systems work together.

### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US-5447353, Yamasaki, 12-19-1995: teaches a photographic image processing system having laboratory unit for processing film and photographer unit for supplying printing information.

US-5936709, Yamamoto, 8-10-1999: teaches an index print preparation and feeding apparatus and photo-printing and developing apparatus including reading of a barcode on a formed image.

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US-6373551, Manico et al., 4-16-2002: teaches a system and method for communication of digital images generated from photographic film, including identifying a server location for stored files.

US-5319401, Hicks, 6-7-1994: teaches control system for photographic equipment.

US-6044156, Honsinger et al., 3-28-2000: teaches a method for generating an improved carrier for use in an image data embedding application, including embedding a message into a printed image.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lucas Divine whose telephone number is 571-272-7432. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**KING Y. POON**  
**PRIMARY EXAMINER**

Lucas Divine  
Examiner  
Art Unit 2624

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